Attorney Docket No. 09792909-5862 PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of:	) Group Art Unit: **1745**
Yukio Miyaki, et al.	) Examiner: **Eugenia Wang**
Application No. **10/821,368**	)
Filed: **April 9, 2004**	)
For: **BATTERY**	)

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Commissioner for Patents
P.O. Box 1450
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APPELLANT'S REPLY BRIEF ON APPEAL

Dear Sir:

In accordance with the provisions of 37 C.F.R. § 41.37, Appellant submits this Reply Brief on Appeal in response to the Examiner's Answer dated January 13, 2011 in the above-identified application.

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I. **No Construction of Fujimoto et al. (EP 0704921 A1) in view of Ikeda et al. (WO 01/29918; U.S. Patent No. 7,241,533) Renders Any of Claims 1, 3 and 4 Obvious.**

A. Fujimoto does not teach or suggest the claimed ratio.

Fujimoto et al. teaches the thickness of the electrode material on the inner side of the collector is from 60% to 97% or more preferably 70 to 95% of the outer collector. The Examiner argues that difference in thickness inherently provides a difference in capacity and, as a result, that a portion of the claimed thickness ratio of Fujimoto et al. covers the claimed ratio. Applicant disagrees.

Specifically, the Examiner overlooks that other factors besides thickness can affect capacity. For example, the density of the active material and grain diameters also impact capacity. Specification, pages 12 and 14. As such, a range as cited by Fujimoto et al., which merely teaches a thickness relationship, could still have varying capacity amounts if an active material is used with a higher density but equal thickness of another active material.

In contrast, all the factors that could affect capacity are considered by the claim limitations because the claims require a general capacity ratio. As such, the thickness, density and grain diameters could vary as long as the overall capacity ratio is within the range required by the claims.

The Examiner also states that the "capacity ratio," as defined in the specification is not a limitation in the claims, and therefore will not be read into the claims. However, "where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim." *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999). Thus, in this case, Applicant

has clearly defined the patent term capacity ratio as the capacity ratio per cm^2 for the inner anode active material layer and the outer anode active material layer. Specification, page 28. Therefore, under the circumstances, the definition of capacity ratio as defined in the specification should control the claim interpretation. In light of this, the thickness relationship as taught by Fujimoto et al., is not the same as the ratio limitation as required by the claims.

B. The claimed capacity ratio is not obvious.

In addition, the capacity ratio required by the claims is not obvious over the thickness range taught by Fujimoto. Prima facie obvious is established when the only difference between a claimed invention and the prior art is the required range or variable. *Titanium Metals Corp. v. Banner*, 778 F.2d 775 (Fed. Cir. 1985).

Here, Fujimoto teaches a coating thickness, which by definition, is the smallest distance of length, width and thickness or the measurement from one surface to its opposite. http://www.merriam-webster.com definition of thickness and thick. Coating thickness and capacity ratio, as properly interpreted, measure different values, i.e. one measures thickness whereas the other measures the relationship of capacity as ratio per cm^2. As such, the difference between Fujimoto and the claimed invention is twofold, because in addition to teaching a different measured value, the required range is also different. Accordingly, prima facie obviousness is not established because the difference between the prior art and the claimed invention is more than just a range or variable.

As such, taken either singularly or in combination with each other, the above cited references fail to teach or even fairly suggest all the requirements of the claims. Thus, claims 1 and 3-10 are patentable over the cited references. Accordingly, Appellant respectfully requests the above rejection be withdrawn.

II. CONCLUSION:

For the foregoing reasons, Appellants respectfully submit that the rejections posed by the Examiner are improper as a matter of law and fact. Accordingly, Appellants respectfully request the Board reverse the rejections of claims 1, 3 and 4.

Respectfully submitted,

Dated: March 11, 2011

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